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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/153,644	09/15/1998	SUZANNE W. DOBBS	05015.0175	5816

7590

01/02/2002

NEEDLE & ROSENBERG  
SUITE 1200 THE CANDLER BUILDING  
127 PEACHTREE STREET NE  
ATLANTA, GA 303031811

EXAMINER

JOYNES, ROBERT M

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 01/02/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/153,644

Applicant(s)

DOBBS ET AL.

Examiner

Robert M. Joynes

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Receipt is acknowledged of applicants' Request for Continued Examination filed on November 5, 2001.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-40 and 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madrange nee Dermain et al. (US 4173627, hereafter "Madrange nee Dermain"). Madrange nee Dermain teaches a hair care composition comprising a lower alkanol, a solvent and a diluent (Col. 3, lines 37-52). The lower alkanol is ethanol, propanol, isopropanol or butanol. (Col. Lines 40-41). The diluent is an alkyl acetate, in particular ethyl acetate or methyl acetate (Col. 3, lines 44-47). Fixatives can also be present (Col. 4, line 28 – Col. 5, line 8). The composition further contains a propellant

(Claims 1 and 4). Madrange nee Dermain teaches the presence of a neutralizer in the composition (Claim 8 and Col. 4, lines 18-27).

Madrange nee Dermain does not expressly include water in their disclosure. However since the reference does not disclose that the ethanol must be absolute or denatured ethanol, it would be obvious to one of ordinary skill in the art at the time the invention was made to use ethanol that is not absolute or denatured with the motivation that the ethanol that is not absolute or denatured may be more readily available or cheaper. Such ethanol contains about 5% water.

The amount of the water is considered a manipulatable parameter that would be obvious to one skilled in the art in an effort to provide a suitable solvent.

Madrange nee Dermain does not expressly disclose 1,1-difluoroethane. The reference does teach difluoroalkane. It is the position of the Examiner that the specific alkane is a limitation that would be routinely determined by one of ordinary skill in the art through minimal experimentation as being suitable absent the presentation of some unusual or unexpected result. The results must be those that occur from the specific limitation.

Madrange nee Dermain does not expressly teach a method of fixing hair. In the absence of criticality, it is the position of the Examiner that the spraying of hair spray onto hair is a well-known method available on any bottle of hair spray.

Applicants again argue that none of the examples of Madrange nee Dermain teach a combination of ethanol or isopropanol with ethyl acetate. The Examiner would like to direct the applicants to Col. 3, lines 37-52 of the reference discussed above.

Section 2123 of the MPEP states, "[d]isclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiment."

Claims 1, 2, 8-10, 16, 17, 31-35, 37, 39—44, 46, 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heeb et al. (US 4243548, hereafter "Heeb"). Heeb teaches an aerosol formulation. The formulation comprises a solvent or mixture of solvents such as ethyl alcohol and methyl acetate (Claims 1-11, Col. 3, lines 3-7).

Applicants argue that Heeb does not teach a hair composition comprising both ethanol and methyl acetate or comprising isopropanol and methyl acetate. Examiner directs applicants to the reference at Claim 1, which recites, "...wherein said organic solvents are selected from the group consisting of...ethyl alcohol, n-propanol, isopropanol, methyl acetate...and mixtures thereof." This reads directly on applicants' claims.

Applicants' arguments regarding the lack of combination in the examples of Heeb are found to be not persuasive for the reasons given above. Section 2123 of the MPEP states, "[d]isclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiment."

Applicants further argue in their Request for Continued Examination that the claimed invention of the instant application achieves advantages over prior compositions. In particular the invention achieves the advantage of (1) reducing the cosmetically unacceptable odor associated with alkyl acetates; (2) inhibiting the hydrolysis of methyl acetate and/or t-butyl acetate in the presence of water to thereby reduce the formation of harmful acids; and (3) reducing volatile organic compound

Art Unit: 1615

content of the hair composition to governmentally acceptable levels. No criticality is seen in these recited advantages and applicants have no shown any evidence of unexpected results or superiority over the prior art.

Therefore, the rejections made in the Final Office Action mailed May 9, 2001 are maintained.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Joynes whose telephone number is (703) 308-8869. The examiner can normally be reached on Monday through Friday 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Robert M. Joynes  
Patent Examiner  
Art Unit 1615  
December 20, 2001

  
THURMAN K. PAGE  
SUPERVISOR, PATENT EXAMINER  
TECHNICAL CENTER 1000